

REMARKS

1. Summary of the office action

In the office action mailed March 13, 2009, (i) the Examiner rejected claims 1, 7-10, 12, 13, 20, 21, 23, 24, 26-28, 31, 33, and 34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0049820 (Barton) in view of U.S. Patent No. 7,039,933 (Chen), (ii) the Examiner rejected claims 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of Chen and U.S. Patent No. 5,272,525 (Borchardt), (iii) the Examiner rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of Chen and U.S. Patent Application Publication No. 2003/0195797 (Klug), (iv) the Examiner rejected claims 1, 7-10, 12, 13, 20, 21, 23, 24, 26-28, 31, 33, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of Official Notice, (v) the Examiner rejected claims 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of the Official Notice and further in view of Borchardt, and (vi) the Examiner rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of the Official Notice and further in view of Klug.

2. Amendments and status of the claims

Applicant has amended claims 1, 20, 21, 27-30, and 33, cancelled claim 24, and added new claims 35 and 36. Now pending in this application are claims 1, 7-10, 12, 13, 20, 21, 23, and 26-36. Of the pending claims, claims 1 and 20 are independent.

Applicant has amended the specification by providing a replacement paragraph for original paragraph 0057. The replacement paragraph recites the reference number for the digital video recorder as 108 instead of 118.

3. Response to rejections of claims 1, 7-10, 12, 13, 20, 21, 23, 24, 26-28, 31, 33, 34

a. Barton and Chen

The Examiner rejected claims 1, 7-10, 12, 13, 20, 21, 23, 24, 26-28, 31, 33, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Barton and Chen. Applicant submits that independent claims 1 and 20, as amended, patentably distinguish over Barton and Chen.

At a minimum, Barton and Chen do not reasonably lead to the DVR placing the ad into the digital video output stream so that the digital video output stream *simultaneously includes the index of programs recorded at the DVR and the ad* but does not include the video of the program recorded at the DVR, wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen *without overlapping* any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR, as recited in claims 1 and 20, as amended.

In rejecting claims 1 and 20 as being obvious over Barton and Chen, the Examiner stated Barton teaches a sequence of 1st mode (menu)...advertising...2nd mode (the requested program). *See*, office action, page 3, lines 1-2. Even if it is assumed, for the sake of argument, that the 1st mode (menu) amounts to the index of programs recorded at the DVR, Applicant submits that Barton does not disclose or suggest a DVR

placing an ad into the digital video output stream so that the digital video output stream *simultaneously includes the index of programs recorded at the DVR and the ad* but does not include the video of the program recorded at the DVR, wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen *without overlapping* any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR, as recited in claims 1 and 20, as amended. Applicant submits that Chen fails to make up for this deficiency of Barton.

Chen, at best, discloses (i) enhanced TV uses certain technologies from the Internet to deliver graphical and informational elements as components on the same screen as a *video program*, (ii) once transmitted over the air or via telephone wires or cables, the components are televised *on top of* video programming as enhancements and viewed on traditional TV sets, computers, and on other video-ready digital products, and (iii) *a TV broadcast* can also be shrunk down on the TV screen to make room for the enhancements which may be displayed beside the TV broadcast. *See*, Chen, column 1, lines 25-32 and lines 43-46. The Examiner identified the graphical and informational elements of Chen as advertising. *See*, office action, page 3, lines 5-6.

Even if it is assumed, for the sake of argument, that Chen's components televised *on top of* the video programming of Barton and Chen are ads, and even if it is further assumed, for the sake of argument, that the video programming of Barton and Chen amounts to an index of programs recorded at the DVR, Applicant submits that televising the components *on top of* the video programming of Chen and Barton does not

reasonably lead to a DVR placing the ad into the digital video output stream so that the digital video output stream simultaneously includes the index of programs recorded at the DVR and the ad but does not include the video of the program recorded at the DVR, wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen *without overlapping* any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR.

Furthermore, Applicant submits that Chen's "TV broadcast" does not amount to an index of programs recorded at the DVR. Indeed, Chen teaches a communications stream, e.g., the TV broadcast, is transmitted by a transmitter of an enhanced TV broadcasting system.

Even if it is assumed, for the sake of argument, that a DVR records Chen's TV broadcast and adds an indicator of the TV broadcast to an index of programs recorded at the DVR, Applicant submits that shrinking down *a TV broadcast* on a TV screen to make room for the enhancements which may be displayed beside the TV broadcast does not amount to the DVR placing the ad into the digital video output stream so that the digital video output stream simultaneously includes the *index of programs recorded at the DVR and the ad* but does not include the video of the program recorded at the DVR, wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen without overlapping any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR, as recited in claims 1 and 20, as amended.

Since Barton and Chen do not reasonably lead to each and every element recited in claims 1 and 20, Applicant submits that claims 1 and 20 are allowable over Barton and Chen. Further, because each of claims 7-10, 12, 13, 21, 23, 26-28, 31, 33, and 34 depends from one of claims 1 and 20 and necessarily includes all of the limitations of one of claims 1 and 20, Applicant submits that claims 7-10, 12, 13, 21, 23, 26-28, 31, 33, and 34 are also allowable over Barton and Chen.

Applicant has cancelled claim 24. Applicant submits that the obviousness rejection of claim 24 over Barton and Chen is moot. Applicant respectfully requests that the Examiner withdraw the obviousness rejection of claim 24 over Barton and Chen.

b. Barton and Official Notice

The Examiner rejected claims 1, 7-10, 12, 13, 20, 21, 23, 24, 26-28, 31, 33, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Barton and the Official Notice recited in the office action at page 6, lines 17-21, and page 7, lines 5-9. Applicant submits that independent claims 1 and 20, as amended, patentably distinguish over Barton and the Official Notice.

At a minimum, Barton and the Official Notice do not reasonably lead to the DVR placing the ad into the digital video output stream so that the digital video output stream *simultaneously includes the index of programs recorded at the DVR and the ad* but does not include the video of the program recorded at the DVR, wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen *without overlapping* any portion of the index of programs

recorded at the DVR or any portion of the video of the program recorded at the DVR, as recited in claims 1 and 20, as amended.

In rejecting claims 1 and 20 as being obvious over Barton and the Official Notice, the Examiner stated Barton teaches a sequence of 1st mode (menu),...advertising...2nd mode (the requested program). *See*, office action, page 6, lines 16-17. Even if it is assumed, for the sake of argument, that the 1st mode (menu) amounts to the index of programs recorded at the DVR, Applicant submits that Barton does not disclose or suggest the DVR placing the ad into the digital video output stream so that the digital video output stream *simultaneously includes the index of programs recorded at the DVR and the ad* but does not include the video of the program recorded at the DVR, wherein *the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen without overlapping any portion of the index of programs recorded at the DVR* or any portion of the video of the program recorded at the DVR, as recited in claims 1 and 20, as amended. Applicant submits that the Official Notice fails to make up for this deficiency of Barton.

The Examiner stated, "Official Notice is taken that it was well known to enhance video content by including visual transitions between portions of video content. Some typical video transitions were called: wipe, dissolve, fade, etc., whereby these techniques help smooth or create fanciful transitions between different video portions. These transitions also provide at least for a limited time *a visual overlap* of two adjoining video sections." *See*, office action, page 6, lines 17-21. Applicant submits that using these alleged well-known techniques to provide at least for a limited time a *visual overlap* of

two adjoining video sections, such as the 1st mode (menu) and advertising of Barton do not reasonably lead to the DVR placing the ad into the digital video output stream so that the digital video output stream *simultaneously includes the index of programs recorded at the DVR and the ad* but does not include the video of the program recorded at the DVR, wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen *without overlapping* any portion of the index of programs recorded by the DVR or any portion of the video of the program recorded at the DVR, as recited in claims 1 and 20, as amended.

Since Barton and the Official Notice do not reasonably lead to each and every element recited in claims 1 and 20, Applicant submits that claims 1 and 20 are allowable over Barton and the Official Notice. Further, because each of claims 7-10, 12, 13, 21, 23, 26-28, 31, 33, and 34 depends from one of claims 1 and 20 and necessarily includes all of the limitations of one of claims 1 and 20, Applicant submits that claims 7-10, 12, 13, 21, 23, 26-28, 31, 33, and 34 are also allowable over Barton and the Official Notice.

Applicant has cancelled claim 24. Applicant submits that the obviousness rejection of claim 24 over Barton and the Official Notice is moot. Applicant respectfully requests that the Examiner withdraw the obviousness rejection of claim 24 over Barton and the Official Notice.

Additionally, the Examiner stated that Applicants have not presented a seasonable challenge to the takings of official notice. *See*, office action, page 10, lines 2-3. Applicant respectfully disagrees. The challenged official notice was recited on pages 6 and 7 of the office action mailed September 17, 2008. The first time this official notice

was taken for this application was in the office action mailed September 17, 2008. Applicant challenged the official notice in Applicant's response to the office action mailed September 17, 2008. Therefore, Applicant submits that the challenge to the official notice was seasonable.

Applicant challenged the official notice used in rejecting claims 1, 20, 21, 24, 26-28, 33, and 34 in the office action mailed September 17, 2008, in part, because the Examiner stated official notice was taken that it *is* well known to enhance video content by including visual transitions between portions of video content. In the office action mailed March 19, 2009, the Examiner stated official notice is taken that it *was* well known to enhance video content by including visual transitions between portions of video contents.

Applicant traverses the Official Notice recited on page 6, lines 17-21, and page 7, lines 5-9. M.P.E.P. § 2144.03 provides that any rejection based on assertions that a fact is well known or common knowledge in the art without documentary evidence to support the Examiner's conclusion should be judicially applied. M.P.E.P. § 2144.03 also provides that any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection.

In rejecting claims 1 and 20, as well as claims 21, 24, 26-28, 33, and 34, the Examiner stated, "Regarding the claimed feature that the advertising is displayed along with the video of the modes, it is unstated whether or not there is any visual overlap from the 1st mode (the menu) into the ad or whether or not there is any visual overlap out of the

ad into the 2nd mode (the requested program).” See, office action, page 6. As far as Applicant can tell, the Examiner used the Official Notice to fill in these gaps of Barton. Applicant submits that the Examiner’s use of the Official Notice to reject claims 1, 20, 21, 24, 26-28, 33, and 34 consists of more than filling in the gaps in an insubstantial manner. Indeed, the Examiner used the Official Notice recited on page 6, lines 17-21, and page 7, lines 5-9 of the office action to fill in the gaps of a single reference that does not teach or suggest all of the elements of claims 1, 20, 21, 24, 26-28, 33, and 34. Therefore, Applicant submits that the Examiner did not properly take official notice in rejecting independent claims 1, 20, 21, 24, 26-28, 33, and 34.

4. Response to rejections of claims 29 and 30

a. Barton, Chen and Borchardt

The Examiner rejected claims 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Barton, Chen, and Borchardt. Claims 29 and 30 depend from claim 1 and necessarily include each and every element of claim 1. As stated above, Barton and Chen do not reasonably lead to the DVR placing the ad into the digital video output stream so that the digital video output stream simultaneously includes the index of programs recorded at the DVR and the ad but does not include the video of the program recorded at the DVR, wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen without overlapping any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR, as recited in claim 1, as amended. Applicant submits that Borchardt does not make up for this deficiency of Barton and

Chen. Since Barton, Chen, and Borchardt do not reasonably lead to each and every element of claims 29 and 30, Applicant submits that claims 29 and 30 are allowable over Barton, Chen, and Borchardt.

b. Barton, Official Notice, and Borchardt

The Examiner rejected claims 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Barton, the Official Notice, and Borchardt. Claims 29 and 30 depend from claim 1 and necessarily include each and every element of claim 1. As stated above, Barton and the Official Notice do not reasonably lead to the DVR placing the ad into the digital video output stream so that the digital video output stream simultaneously includes the index of programs recorded at the DVR and the ad but does not include the video of the program recorded at the DVR, wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen without overlapping any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR, as recited in claim 1, as amended. Applicant submits that Borchardt does not make up for this deficiency of Barton and the Official Notice. Since Barton, the Official Notice, and Borchardt do not reasonably lead to each and every element of claims 29 and 30, Applicant submits that claims 29 and 30 are allowable over Barton, the Official Notice, and Borchardt.

5. Response to rejections of claim 32

a. Barton, Chen, and Klug

The Examiner rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Barton, Chen, and Klug. Claim 32 depends from claim 1 and necessarily includes

each and every element of claim 1. As stated above, Barton and Chen do not reasonably lead to the DVR placing the ad into the digital video output stream so that the digital video output stream simultaneously includes the index of programs recorded at the DVR and the ad but does not include the video of the program recorded at the DVR, wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen without overlapping any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR, as recited in amended claim 1. Applicant submits that Klug does not make up for this deficiency of Barton and Chen. Since Barton, Chen, and Klug do not reasonably lead to each and every element of claim 32, Applicant submits that claim 32 is allowable over Barton, Chen, and Klug.

b. Barton, Official Notice, and Klug

The Examiner rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Barton, the Official Notice, and Klug. Claim 32 depends from claim 1 and necessarily includes each and every element of claim 1. As stated above, Barton and Chen do not reasonably lead to the DVR placing the ad into the digital video output stream so that the digital video output stream simultaneously includes the index of programs recorded at the DVR and the ad but does not include the video of the program recorded at the DVR, wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen without overlapping any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR, as recited in amended claim 1. Applicant

submits that Klug does not make up for this deficiency of Barton and Chen. Since Barton, the Official Notice, and Klug do not reasonably lead to each and every element of claim 32, Applicant submits that claim 32 is allowable over Barton, the Official Notice, and Klug.

6. Conclusion

Applicant believes that all of the pending claims have been addressed in this response. However, failure to address a specific rejection or assertion made by the Examiner does not signify that Applicant agrees with or concedes that rejection or assertion.

For the foregoing reasons, Applicant submits that claims 1, 7-10, 12, 13, 20, 21, 23, and 26-36 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all of the claims.

Respectfully submitted,

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